

# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,377	02/11/2004	Catherine M. Phillips	555255-012-711	3930

33787 7590 08/11/2006  
JOHN J. OSKOREP, ESQ.  
ONE MAGNIFICENT MILE CENTER  
980 N. MICHIGAN AVE.  
SUITE 1400  
CHICAGO, IL 60611

EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT PAPER NUMBER

2617

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/776,377

Applicant(s)

PHILLIPS ET AL.

Examiner

Naghmeh Mehrpour

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Information Disclosure Statement

1. The information disclosure statement filed reference listed in the information Disclosure Submitted on 01/17/06 have been considered by the examiner (see attached PTO-1449

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-24**, are rejected under 35 U.S.C. 103(a) as being unpatentable over McElwain et al.(US patent Number 2003/0022689 A1) in view of Hicks et al. (US Patent 7,027,813 A1).

Regarding claims 1, 10, McElwain teaches in a mobile station, a method of selecting a communication network comprising:

scanning to identify a plurality of communication networks in a coverage area within which the mobile station is operating (0048);

visually displaying the plurality of network identifiers (0054);

receiving a user input selection of one of the communication networks after  
visually displaying the plurality of network identifiers (0054); and  
registering with the selected communication network (0056).

McElwain fails teach retrieving a plurality of network identifiers corresponding to the plurality of communication networks in accordance with an Enhanced Operator Name String (EONS) protocol. However, Hicks teaches retrieving a plurality of network identifiers corresponding to the plurality of communication networks in accordance with an Enhanced Operator Name String (EONS) protocol (col 1 lines 64-67, col 2 lines 1-10). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Regarding claims 2, 11, McElwain fails to teach a method/mobile of claim 1, wherein the act of retrieving comprises retrieving each network identifier based on a country code, a region code, and a cell number. However, Hicks teaches a method/mobile of claim 1, wherein the act of retrieving comprises retrieving each network identifier based on a country code, a region code, and a cell number (col 2 lines 25-40). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Art Unit: 2617

Regarding claims 3, 12, McElwain fails to teach a method/mobile of claim 1, wherein the act of retrieving comprises retrieving each network identifier based on a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC).

However, Hicks teaches a method/mobile of claim 1, wherein the act of retrieving comprises retrieving each network identifier based on a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC) (co 1 lines 64-67, col 2 lines 1-10). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Regarding claims 4, 13, McElwain teaches a method/mobile of claim 1, wherein the plurality of network identifiers comprises at least two network identifiers that are substantially the same (0039).

Regarding claims 5, 14, McElwain teaches a method/mobile of claim 1, wherein the act of retrieving comprises retrieving from memory of a Subscriber Identity Module (SIM) (0038).

Regarding claims 6, 15, McElwain teaches a method/mobile of claim 1, further comprising:

visually displaying the network identifier corresponding to the selected communication network (0054).

Regarding claim 7, McElwain teaches a method of claim 1, wherein the act of retrieving comprises retrieving from memory of a Subscriber Identity Module (SIM) (0038); comprising:  
visually displaying the network identifier corresponding to the selected communication network (0054). McElwain fails to teach a method retrieving from SIM based on a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC) . However, Hicks teaches a method retrieving from SIM based on a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC) (col 1 lines 25-40). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Regarding claims 8, McElwain teaches a method of claim 1, wherein the mobile station comprises a Global System for Mobile (GSM) and General Packet Radio Service (GPRS) compatible mobile station (0048).

Regarding claim 9, McElwain fails to teach a method of claim 1, comprising the further act of: providing an automatic network selection method based on the EONS protocol. However, Hicks teaches a method of claim 1, comprising the further act of:

Art Unit: 2617

providing an automatic network selection method based on the EONS protocol (col 1 lines 64-67, col 2 lines 1-18). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Regarding claim 16, McElwain fails to teach a mobile station of claim 15, wherein the processor is further operative to retrieve each network identifier based a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC).

However, Hickes teaches a mobile station of claim 15, wherein the processor is further operative to retrieve each network identifier based a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC) (col 2 lines 25-40).

Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Regarding claim 17, McElwain teaches a mobile station of claim 10, further comprising: a Subscriber Identity Module (SIM) interface through which the processor is operative to retrieve the plurality of network identifiers (0038); the visual display is further operative to visually display the network identifier corresponding to the selected communication network (0054).

Art Unit: 2617

McElwain fails to teach a mobile wherein the processor is further operative to retrieve each network identifier through the SIM interface based a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC). However, Hicks teaches a mobile wherein the processor is further operative to retrieve each network identifier through the SIM interface based a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC) 9col 2 lines 25-40). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Regarding claim 18, McElwain teaches a mobile station of claim 10, further comprising a Global System for Mobile (GSM) and General Packet Radio Service (GPRS) compatible mobile station (0048)

Regarding claims 19, 21, McElwain teaches a method of manually selecting a communication network in a mobile station comprising the acts of:

- scanning to identify a plurality of communication networks in a coverage area within which the mobile station is operating (0048);

- simultaneously visually displaying the plurality of network identifiers, including at least two network identifiers that are substantially identical (0054);



receiving a user input selection of one of the communication networks after visually displaying the plurality of network identifiers; **in a manual network selection technique** (0054);

registering with the selected communication network (0054); and  
visually displaying the network identifier associated with the selected communication network (0056). McElwain fails to teach a method of manually selecting a communication network in a mobile station comprising the acts of:  
retrieving, from memory of a Subscriber Identity Module (SIM), a plurality of network identifiers corresponding to the plurality of communication networks in accordance with an Enhanced Operator Name String (EONS) protocol;

wherein each network identifier is retrieved based on a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC). However, Hicks teaches teach a method of manually selecting a communication network in a mobile station comprising the acts of:  
retrieving, from memory of a Subscriber Identity Module (SIM), a plurality of network identifiers corresponding to the plurality of communication networks in accordance with an Enhanced Operator Name String (EONS) protocol (col 1 lines 64-67, col 2 lines 1-25);

wherein each network identifier is retrieved based on a Mobile Country Code (MCC), a Mobile Network Code (MNC), and a Location Area Code (LAC) (col 2 lines 25-40). Therefore, it would have been obvious to ordinary skill in the art at the time the

Art Unit: 2617

invention was made to combine the above teaching of Hicks with McElwain, in order to provide determining whether the mobile is in a home area or in a roaming area.

Regarding claims 20, McElwain teaches a method of claim 19, wherein the mobile station comprises a Global System for Mobile (GSM) and General Packet Radio Service (GPRS) compatible mobile station (0048).

Regarding claim 22, McElwain teaches a mobile station of claim 21, comprising a Global System for Mobile (GSM) and General Packet Radio Service (GPRS) compatible mobile station (0048).

Regarding claim 23, McElwain teaches a mobile station of claim 21, wherein the processor is further operative to retrieve the plurality of network identifiers from memory of the SIM (0038).

Regarding claim 24, McElwain teaches a mobile station of claim 21, wherein at least two network identifiers which are retrieved and visually displayed are substantially the same (0054).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-24, have been considered but are moot in view of the new ground(s) of rejection.

### Conclusion

4. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

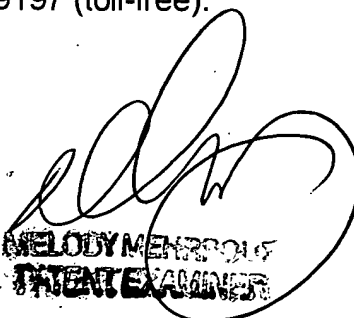
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro be reached (571) 272-7876.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

July 25, 2006



MELODY MENZIES  
PATENT EXAMINER